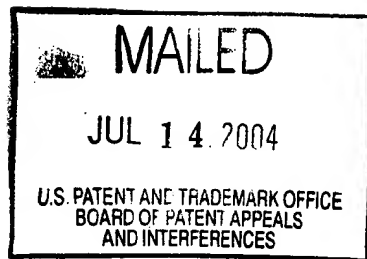


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHERYL LANIER,
LARRY P. DAVIS, JAMES P. SULLIVAN
and
MELANIE SCHMUTZ-NUGENT

Appeal No. 2004-0080
Application 09/473,853

ON BRIEF

Before FRANKFORT, McQUADE and NASE, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 10 and 11, all of the claims remaining in this application. Claims 1 through 9 and 12 have been canceled.

Appellants' invention is directed to a method for cashing a check presented by an individual at a gambling establishment and, more particularly, for automatically identifying from a host computer database containing exclusion information if the individual involved (i.e., the check writer) is listed on an exclusion or disassociated persons list compiled by the state gaming commission and thus is to be barred from the gambling establishment. As noted on page 3 of the specification, an objective of the invention is to ensure that individuals who are listed on an exclusion list as disassociated check writers by the gaming commission are identified, prevented from cashing checks at the casino and removed from the premises as required by law. Independent claim 10 is representative of the subject matter on appeal and a copy that claim can be found in the Appendix to appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the claims on appeal are:

Templeton et al. (Templeton) 5,679,938 Oct. 21, 1997

Illinois Gaming Board Regulations, Title 86, Part 3000,
SS 700, 710, 720, 725, 730, 740 (effective no later than
April 1, 1997).

Claims 10 and 11 stand rejected under 35 U.S.C.
§ 103(a) as being unpatentable over Templeton in view of the
Illinois Gaming Board Regulations.

Rather than attempt to reiterate the examiner's full
commentary with regard to the above-noted § 103 rejection and the
conflicting viewpoints advanced by appellants and the examiner
regarding that rejection, we make reference to the final
rejection (Paper No. 8, mailed April 22, 2002) and the examiner's
answer (Paper No. 15, mailed April 7, 2003) for the reasoning in
support of the rejection, and to appellants' brief (Paper No. 14,
filed January 22, 2003) and reply brief (Paper No. 16, filed
June 9, 2003) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given
careful consideration to appellants' specification and claims, to
the applied prior art references, and to the respective positions
articulated by appellants and the examiner. As a consequence of

our review, we have made the determination that the above-noted § 103 rejection will not be sustained. Our reasons follow.

In the rejection of claims 10 and 11 under 35 U.S.C. § 103(a), the examiner urges (final rejection, pages 2-4) that Templeton's method for cashing a check presented by an individual discloses the invention "substantially as claimed," except that Templeton does not disclose the use of an exclusion list particularly for persons excluded from gambling. The examiner next points to the Illinois Gaming Board Regulations concerning exclusion of persons from gambling, asserting that this reference teaches the feature missing in Templeton and expressly discloses that a person will be placed on a gambling exclusion list if "convicted of a felony in any jurisdiction, of any crime of moral turpitude or of a crime involving gaming." From the teachings of the applied prior art references, the examiner then concludes that it would have been obvious to one of ordinary skill in the art at the time of appellants' invention to have modified the system/method for check cashing approval disclosed by Templeton to detect the excluded persons described by the Illinois Gaming

Board Regulations and prevent their check cashing "because this would have allowed regulatory boards to prevent such persons from obtaining cash to gamble at establishments where such persons were prohibited from gambling."

Appellants argue, and we strongly agree, that the examiner's attempted combination of the disparate subject matter and teachings of Templeton's check authorization system and the Illinois Gaming Board's Regulations concerning persons to be excluded from gambling is an improper exercise in hindsight reconstruction of the claimed invention based on appellants' own teachings. In that regard, we note, as our court of review indicated in In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), that it is impermissible for the examiner to use the claimed invention as an instruction manual or "template" in attempting to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious.

In the present case, while Templeton discloses an interactive check authorization/acceptance system and method for use by merchants, which system and method uses checking account identifiers to access an exclusion list of checking accounts and/or individuals in order to effectively differentiate between good and bad checks and thus prevent bad checks from being cashed by a subscribing merchant, we see nothing in Templeton concerning gambling establishments or lists of persons the gaming commission has determined must be excluded from gambling establishments. By comparison, the Illinois Gaming Board Regulations pointed to by the examiner merely disclose the existence of an exclusion list for individuals barred from entry into gambling operations, set forth criteria for placement on such an exclusion list, indicate the type of information about an individual to be included on such a list, and place the burden on a gambling licensee and his employees to exclude or eject from a gambling operation any Excluded Person when such licensee or employee knows or reasonably should know of the presence of such Excluded Person. The objective of the Illinois Gaming Board Regulations is to prevent Excluded Persons from entering the premises of a gambling

Appeal No. 2004-0080
Application 09/473,853

operation and to require or authorize a gambling licensee and his employees to eject such an Excluded Person if such an individual has gained access to a gambling establishment. There is clearly nothing in the Illinois Gaming Board Regulations concerning a method for cashing a check presented by an individual at a gambling establishment.

In the context of this application, we also note that the mere fact that the applied prior art could be modified in the manner urged by the examiner would not have made such a modification obvious unless the prior art suggested the desirability of the modification. See, for example, In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In this case, it is our opinion that the prior art relied upon by the examiner does not contain such a suggestion and that the examiner has impermissibly drawn from appellants' own teaching and fallen victim to what our reviewing Court has called "the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W.L. Gore

Appeal No. 2004-0080
Application 09/473,853

& Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Since we have determined that the teachings and suggestions found in Templeton and the Illinois Gaming Board Regulations would not have made the subject matter as a whole of independent claim 10 on appeal obvious to one of ordinary skill in the art at the time of appellants' invention, we must refuse to sustain the examiner's rejection of that claim under 35 U.S.C. § 103(a). It follows that the examiner's rejection of dependent claim 11 under 35 U.S.C. § 103(a) on the basis of the combined teachings of Templeton and the Illinois Gaming Board Regulations will likewise not be sustained.

Accordingly, the decision of the examiner to reject claims 10 and 11 of the present application under 35 U.S.C. § 103(a) is reversed.


In addition to the foregoing, we REMAND this application to the examiner for a decision on the record as to


whether or not a rejection of claims 10 and 11 on appeal would be appropriate based on the method for cashing a check presented by an individual at a gambling establishment as described in the "Background Art" section of appellants' specification considered in view of the disclosure and teachings of the interactive check authorization system and method of Templeton. More particularly, the examiner should determine if it would have been obvious to one of ordinary skill in the art at the time of appellants' invention to implement the apparently cumbersome and time consuming manual check cashing method identified by appellants as "Background Art" in their specification by using an automated check authorization/cashing system and method like that disclosed in Templeton.


Appeal No. 2004-0080
Application 09/473,853

This application, by virtue of its "special" status,
requires immediate action, see MPEP § 708.01 (Eighth Edition,
Rev. 1, February 2003), item (D).

REVERSED AND REMANDED


CHARLES E. FRANKFORT
Administrative Patent Judge


JOHN P. MCQUADE
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge

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Appeal No. 2004-0080
Application 09/473,853.

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